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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,160	01/19/2001	Tetsuo Minakawa	1095.1151/JDH	7615

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EXAMINER	
PHAM, THOMAS K	

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/764,160	MINAKAWA ET AL.	
	Examiner	Art Unit	
	Thomas K Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Quotations of U.S. Code Title 35

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

4. Claims 1-6, 8 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent no. 5,832,451 ("Flake") in view of U.S. Patent No. 6,324,650 ("Ogilvie")

Regarding claims 1, 10 and 11

Flake teaches an intermediation control apparatus that carries out intermediation between a user and a service provider, the intermediation control apparatus comprising: extracting said range of personal information from said personal information (col. 19 lines 2-8, "system 10 ... requesting customer."); and transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 19 lines 8-15, "the system ... travel request"). Flake does not teach extraction means for determining a range of permitted personal information of a user, for disclosure, based on a kind of commodity request information sent from said user. However, Ogilvie teaches a software to determine when and what sensitive information of a user to be disclose as permitted by the user when certain disclosure conditions set by the information provider are met (col. 10 lines 12-55, "a formatting step 306 ... disclosure by the system") for the purpose of keeping personal information secret until allowed to be disclose under certain disclosure conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software of Ogilvie with the system of Flake because it would provide for the purpose of keeping personal information secret until allowed to be disclose under certain disclosure conditions.

Regarding claim 2

Flake teaches an intermediation control apparatus according to claim 1, further including

memory means for storing said personal information together with a user ID of said user (col. 7 lines 49-55, "the travel agent ... device 24").

Regarding claim 3

Flake teaches an intermediation control apparatus according to claim 2, wherein said extraction means is responsive to said request information including said user ID (col. 8 lines 58-65, "If the current ... software subroutine 134"), for determining disclosure information of said personal information stored in said storage means based on said user ID and said kind of said request information, and extracting said disclosure information from said personal information (col. 8 lines 33-47, "A customer ... with the queue.").

Regarding claim 4

Flake teaches an intermediation control apparatus, wherein said transaction means makes said extracted range of personal information and said contents of said request available to said service provider on a site (col. 19 lines 8-15, "the system ... travel request") and Ogilvie teaches the user is permitted to access the personal information of user through authentication (col. 6 lines 49-56, "entering sensitive information ... is not received on time").

Regarding claim 5

Flake teaches an intermediation control apparatus according to claim 1, further including a management table for managing correlation between said contents of said request and disclosure information of said personal information (col. 3 line 53 to col. 4 line 3, "a relational database ... preferred vendors").

Regarding claim 6

Flake teaches an intermediation control apparatus according to claim 5, wherein said extraction

means determines said disclosure information based on said management table (col. 4 lines 60-67, "The business ... profile information").

Regarding claims 8, 14 and 15

Flake teaches a service providing apparatus connected to a network, comprising: disclosure information-receiving means for receiving disclosure information as a portion of request commodity information received from a user, (col. 19 lines 2-8, "system 10 ... requesting customer."); and response information-transmitting means for transmitting commodity information created based on said disclosure information, as response information (col. 19 lines 8-15, "the system ... travel request"). Flake does not teach the disclosure portion being permitted to be disclosed by the user. However, Ogilvie teaches a software to determine when and what sensitive information of a user to be disclose as permitted by the user when certain disclosure conditions set by the information provider are met (col. 10 lines 12-55, "a formatting step 306 ... disclosure by the system") for the purpose of keeping personal information secret until allowed to be disclose under certain disclosure conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software of Ogilvie with the system of Flake because it would provide for the purpose of keeping personal information secret until allowed to be disclose under certain disclosure conditions.

Regarding claim 12

Flake teaches an intermediation control method between a user and at least one service provider, comprising: extracting a range of information of a user based on a request sent by the user and the correlation, and providing the extracted range of information to the at least one service provider (col. 19 lines 2-8, "system 10 ... requesting customer."). Flake does not teach

generating a look-up table having information regarding requests from a user, wherein the information is correlated with items of disclosure. However, Ogilvie teaches a software to determine when and what sensitive information of a user to be disclose as permitted by the user when certain stored disclosure conditions are checked (col. 10 lines 12-55, "a formatting step 306 ... disclosure by the system") for the purpose of keeping personal information secret until allowed to be disclose the conditions are checked against the look-up table of the stored disclosure conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the stored disclosure conditions of Ogilvie with the system of Flake because it would provide for the purpose of keeping personal information secret until allowed to be disclose the conditions are checked against the look-up table of the stored disclosure conditions.

Regarding claim 13

Flake teaches an intermediation control apparatus between a user and at least one service provider, comprising: an extraction unit for determining a range of personal information of a user based on a type of request information sent by the user to the at least one service provider (col. 19 lines 2-8, "system 10 ... requesting customer."); and a transaction unit for providing the extracted range of personal information of the user to the at least one service provider (col. 19 lines 8-15, "the system ... travel request"). Flake does not teach the disclosure portion being permitted to be disclosed by the user. However, Ogilvie teaches a software determines when and what sensitive information of a user to be disclose as permitted by the user when certain disclosure conditions set by the information provider are met (col. 10 lines 12-55, "a formatting step 306 ... disclosure by the system") for the purpose of keeping personal information secret

until allowed to be disclose under certain disclosure conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software of Ogilvie with the system of Flake because it would provide for the purpose of keeping personal information secret until allowed to be disclose under certain disclosure conditions.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flake in view of Ogilvie and further in view of U.S. Patent no. 4,831,526 ("Luchs").

Regarding claims 7 and 9

Flake and Ogilvie teach a service providing apparatus, wherein the portion of a request information sent from the user being permitted to be disclosed but do not teach the disclosure information-receiving means is a portion of a request of an estimate of an insurance. However, Luchs teaches the disclosure information-receiving means is a portion of a request of an estimate of an insurance (col. 3 lines 29-38, "Although all ... his insurance.") for the purpose of quoting the premium which would be due to transmit back to the user in a matter of seconds. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the insurance estimate transaction of Luchs with the systems of Flake and Ogilvie because it would provide for the purpose of quoting the premium which would be due to transmit back to the user in a matter of seconds.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 and fax number is (703) 746-8874, Monday-Thursday and every other Friday from 7:30AM- 5:00PM EST or contact Supervisor *Mr. Anthony Knight* at *(703) 308-3179.*

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.** Responses may also be faxed to the **official fax number (703) 872- 9306.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner
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July 16, 2004

Anthony Knight
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